

REMARKS

I. Status of the Claims

Claims 1-91 are pending. No claims have been amended by this Response.

II. Rejections Under 35 U.S.C. § 103(a)

An examiner has the initial duty of supplying the factual basis for an obviousness rejection. Particularly, an examiner must present sufficient facts to establish each of the following three requirements for a *prima facie* case of obviousness: (1) the prior art teaches or suggests each and every claimed limitation, (2) a motivation would have existed to modify and/or combine the references in such a manner as to yield the claimed invention; and (3) a reasonable expectation of success would have existed in making the claimed invention. Here, the Examiner has failed to proffer any concrete facts to support the rejections and has instead relied on conjecture and hindsight, as discussed below.

A. Rejection Over Grollier

The Examiner has maintained the rejection of Claims 1-6, 9-20, 26, 29-39, and 43-91 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,842,849 to Grollier et al. ("Grollier"), for the reasons disclosed on pages 2-3 of the final Office Action. Applicants continue to traverse the rejection for reasons of record and the additional reasons set forth below.

In the present Office Action, the Examiner advances a single argument in support of the rejection – sufficient motivation would have existed to make a dyeing composition comprising any combination of cationic polymers including the cyclohomopolymers and quaternary ammonium polymers as presently claimed "because all these cationic

polymers are suggested by the prior art and are available to . . . be used in dyeing compositions with a reasonable expectation of achieving composition[s] for dyeing hair."

These contentions are conclusory and improper.

1. *Grollier* Does Not Teach or Suggest Each Claim Limitation

First, *Grollier* fails to teach or suggest the claim limitation "at least one quaternary polyammonium polymer;" thus, the rejection is improper for this reason alone. The presently pending claims recite "at least one quaternary polyammonium polymer chosen from (i) polymers comprising repeating units of formula (a) . . . and (ii) polyquaternary ammonium polymers comprising repeating units of formula (VIII)"

Claim 1. *Grollier*, however, does not disclose a quaternary polyammonium polymer of formula (i) and moreover, fails to disclose polymers corresponding to formula (ii) as well.

Regardless, the Examiner continues to point to the polymers of formula (IV) of *Grollier* as evidence of this limitation. This formula, however, encompasses a huge number of poly-(quaternary ammonium) compounds. Each variable for formula (IV) disclosed in *Grollier* is very broadly defined. See, e.g., col. 5, line 66 - col. 6, line 31 ("R1 and R2, and R3 and R4, which are identical or different, represent aliphatic, alicyclic, or arylaliphatic radicals"). Thus, the odds of one skilled in the art selecting the presently claimed sub-genus, i.e., where R₁-R₄ are C₁-C₄ alkyl or hydroxyalkyl groups, from *Grollier*'s disclosure are quite slim and certainly not sufficient to be the basis for an obviousness rejection.

Indeed, this impossibility is further highlighted by the fact that the reference discloses no preference or partiality for the claimed subgenera. Nothing in *Grollier*'s disclosure would have provided any suggestion, or even a hint, to select any species or

sub-genera, let alone the sub-genera presently claimed, to use in conjunction with the other claimed ingredients.

In making this rejection, it appears that the Examiner has failed to follow certain mandates laid out in the M.P.E.P. Particularly, the M.P.E.P. instructs examiners to make express fact-findings “specifically articulat[ing] what teachings or suggestions in the prior art would have motivated one of ordinary skill in the art to select the claimed species or sub-genus.” M.P.E.P. § 2144.8(II)(A)(5). Here, however, the Examiner has made no such findings. Instead, he has simply presumed that *Grollier* teaches each limitation. But a *prima facie* case of obviousness cannot be based on presumptions. Rather, some showing must be made that is sufficient to support the selection of a species or subgenus, and, ultimately a conclusion of obviousness. M.P.E.P. § 2144.8(II)(A)(4)(f). Thus, for at least this reason the rejection is improper and should be withdrawn.

2. The Examiner has not Shown That a Motivation Would Have Existed

The rejection is also improper because the Examiner’s reliance on case law to establish a motivation to make the claimed invention is unwarranted. In the Office Action, the Examiner relies on *In re Heck* for the proposition that a patent is “not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *Office Action*, page 2. In addition, the Examiner relies on *Merck & Co. v. Biocraft Laboratories*, for the proposition that “a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including

non-preferred embodiments.” *Id.*, pages 2-3. While the Applicants do not disagree with these general propositions, Applicants do disagree with the application of these holdings to the present facts.

Specifically, the Examiner relies on these holdings as a short-cut means for establishing a *prima facie* of case of obviousness. This is improper. While it is true that a prior art reference may be relied on in its entirety, including non-preferred embodiments, an examiner still must make factual findings of a motivation to make the claimed invention. In other words, something, such as some reason or explanation, must be present in the prior art that demonstrates, to one of ordinary skill in the art, that the claimed invention would have been desirable.

According to the Examiner, that reason is the mere fact that various types of cationic polymers are known in the art. This, however, is an insufficient reason. *Grollier* provides not even the faintest suggestion as to *why* it would be desirable, when creating a dye composition, to combine (1) at least one oxidation dye; and (2) a combination comprising at least one cyclohomopolymer of dialkyldiallylammonium and at least one particular quaternary polyammonium. Indeed, it would have been equally plausible, based on *Grollier*’s broad disclosure, to select cationic silicone polymers and amphoteric polymers comprising zwitterionic units. Simply put, using the Examiner’s logic, *Grollier*’s disclosure could form the basis for any rejection based on *any* combination of cosmetic ingredients disclosed therein.

Applicants’ own disclosure provides the only suggestion that the presently claimed combination of cationic polymers in an oxidation dyeing composition can remedy at least one of the following drawbacks – roughness, difficulty in disentangling,

and fragility. Specification, para. [005]. This disclosure is contrary to *Grollier's* statement that the combination of cationic polymers with anionic polymers containing vinylsulphonic units overcomes similar difficulties. Col. 1, lines 52-59. Thus, the presently claimed invention could not have been suggested by *Grollier* except by hindsight.

Moreover, although a disclosure can be relied on for all it teaches, this rule does have limits. A disclosure can only be relied on for what it *reasonably* teaches. Here, however, it is not reasonable to conclude that any combination of cationic polymers is suggested by the prior art. Indeed, it is a known rule that "combination claims can consist of combinations of old elements as well as new elements." *Clearstream Wastewater Sys. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446, 54 USPQ2d 1185, 1189-90 (Fed. Cir. 2000).

To avoid violating this rule, the M.P.E.P. requires the Examiner to provide factual support for an obviousness rejection. M.P.E.P. § 2142. Here, the Examiner has made no findings, for example, that (1) *Grollier* suggests that a combination of two cationic polymers in an acid dye composition would have resulted in an improvement over the prior art or that (2) *Grollier* teaches that the claimed combination of ingredients would have resulted in a composition that provided improved hair properties while still preserving or improving dyeing properties. Accordingly, for at least this additional reason, the rejection should be withdrawn.

B. Rejection of Grollier in view of De la Mettrie

The Examiner also rejects claims 7-8, 21-25, 27-28, and 40-42 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,976,195 to *de la Mettrie et al.* in view

of *Grollier* for the reasons disclosed on page 2 of the Office Action. Applicants respectfully traverse this rejection for the reasons of record and the following additional reason.

Even if *Grollier* is combined with *de le Mettrie*, this further combination would still not have led one skilled in the art to select the cationic polymers, oxidation bases, and oxidizing agents of *de le Mettrie* to add to the multitude of components disclosed in *Grollier*. *De le Mettrie* simply does not suggest the use of these ingredients with those presently claimed. Thus, the odds of selecting the claimed dye components and polymers from the teachings of *Grollier* and *de la Mettrie* would have been remote at best, simply based on the number of ingredients disclosed in both references. This is not the standard for obviousness. Accordingly, for at least this reason, the rejection should be withdrawn.

III. Conclusion

In view of the foregoing comments and remarks, Applicants respectfully request reconsideration and reexamination of the pending claims.

**Attorney Docket No. 05725.0826-00
Application No. 09/750,717
Customer No. 22,852**

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 9, 2005

By: Mareesa A. Frederick
Mareesa A. Frederick
Reg. No. 55,190